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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/710,437	07/11/2004	Yo-Shen Lin	CMDP0011USA	4436

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NORTH AMERICA INTELLECTUAL PROPERTY CORPORATION
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EXAMINER

GLENN, KIMBERLY E

ART UNIT	PAPER NUMBER
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2817

DATE MAILED: 11/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

ETC

Office Action Summary	Application No.		Applicant(s)	
	10/710,437		LIN ET AL.	
	Examiner		Art Unit	
	Kimberly E. Glenn		2817	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/11/04</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim 3 is objected to because of the following informalities: "forth" recited in lines 17 and 26 should be changed to - -fourth- -. Appropriate correction is required.

Claims 9 and 16 are objected to because of the following informalities: " the ground" recited in line 2 of both claims should be changed to - - the ground plane- -. Appropriate correction is required

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 3-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant recites the limitation that an uppermost layer of the first series of layers the multilayered substrate is immediately adjacent to a lowermost layer of the second series of layers of the multilayered substrate. It is unclear how the uppermost layer and the lowermost layer can be adjacent to each other.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regards to claim 1, applicant recites " a first port" in line 12. Is this the same first port recited in line 7 or a different port?

With regards to claims 2 and 12, the recitation that the high pass filter is disposed on a first series of layers of the multilayered substrate is inconsistent with the limitation recited on claim 1 that states that the low pass filter is disposed on a first series of layers of the multilayered substrate. This inconsistency is also true of the recitation that the low pass filter is disposed on a second series of layers of the multilayered substrate. Consistency must be maintained throughout the dependent claims. Therefore, the limitation that the low pass filter is disposed on the first series of layers and the high pass filter is disposed on the second series of layers must be maintained.

With regards to claims 4-6 and 13-15, applicant recites inductive and capacitive elements. There is no antecedent basis for these terms. Examiner suggest applicant recites that the circuit elements of the low pass and high pass filters are composed of inductive and capacitive elements or recite the specific inductor or capacitor plates with regards to claims 13-15. With regards to the limitation " at least one inductive (or capacitive) element of filter circuits", does this limitation mean that one inductive (or capacitive) element from each of the low pass and high pass filters are formed on a plurality of layers or that one inductive (or capacitive) element from either the low pass or high pass filter are formed on a plurality of layers?

Claim 8 recites the limitation "the third and fifth capacitor plates" in lines 2 and 3. There is insufficient antecedent basis for this limitation in the claim.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Hiraka et al US Patent 6,366,564, Vanoverschelde et al US Patent 6,734,767, Park US Patent 6,911,708, Shin et al US Patent 6,876,840, Tanaka et al US Patent 6,563,396 and Furuya et al US Patent 6,927,648.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly E. Glenn whose telephone number is (571)-272-1761. The examiner can normally be reached on Monday-Friday 7:30 to 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pascal can be reached on (571)-272-1769. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kimberly E Glenn

Examiner
Art Unit 2817

keg

Robert J. [Signature]

Supervisory Patent Examiner
Technology Center 2000